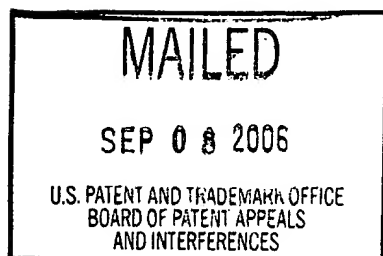


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

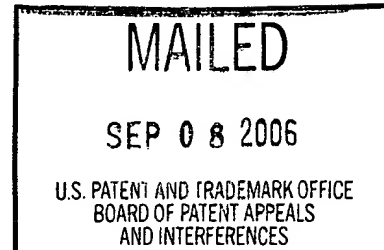
**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte STEPHEN W. COMISKEY and TIMOTHY H. MEYERS



Appeal No. 2006-2039
Application No. 09/520,763

HEARD: August 10, 2006



Before CRAWFORD, LEVY, and FETTING, Administrative Patent Judges.
CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 58 to 75, which are all of the claims pending in this application. Claims 1 to 57 have been cancelled.

BACKGROUND

The appellants' invention relates to a method for managing financial assets (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

THE PRIOR ART

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

| | | |
|----------------------------|-----------|---------------------------------------|
| McGovern et al. (McGovern) | 5,918,207 | June 29, 1999 |
| Moran | 6,430,542 | Aug. 6, 2002 (filed Aug. 26, 1998) |

Upbin, "Old Money Chasing New" Forbes, Jun. 15, 1998, vol. 161, iss. 12., pp.176-180

The VIP Forum, Fact Brief, Family Services, February 2000

THE REJECTIONS

Claims 58 to 64, 66 to 72, 74 to 75 stand rejected under 35 U.S.C. § 103 as being unpatentable over Moran in view of McGovern and VP Forum.

Claims 65 and 73 stand rejected under 35 U.S.C. § 103 as being unpatentable over Moran, McGovern, and VP Forum in view of Upbin.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed April 26, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed March 19, 2004) and reply brief (filed June 28, 2004) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The examiner has rejected the claims under 35 U.S.C. § 103. The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

The appellants' invention is a computer implemented method for providing financial services to a client which are deployed according to a selectable set of criteria. As depicted in Figure 1 the method includes assigning services to each of three service provider groups (specification at page 5). The assignment of services to the groups is done by first determining whether the service is of high value to the customer and whether the services are frequently needed by the client. Those services that are of high value and frequently needed are assigned to a core service group. The services that are of high value but are not used frequently and the services that are used frequently but not of high value are assigned to an affiliated group. Services that are not of high value and not used frequently are assigned to a non-affiliated group

(specification at page 5, Figure 1). The services are provided in a hierarchical manner from the core, affiliated and non-affiliated groups (see Figure 3).

We turn first to the examiner's rejection of claims 58 to 64, 66 to 72, 74 and 75 under 35 U.S.C. § 103 as being unpatentable over Moran in view of McGovern and VPForum. The examiner finds that Moran discloses the invention as claimed except that Moran does not explicitly disclose classifying service providers in a hierarchical manner from the core service provider group, the affiliated service provider group and the non-affiliated service provider group in response to the received client data, assigning a plurality of services to a plurality of provider groups wherein whether each service is needed by the client on a frequent basis and the value of the service are determined and the services are categorized into a core, affiliated and non-affiliated service provider [answer at page 4]. The examiner relies on McGovern for teaching automatic searches of candidates to match customer's needs and presenting the candidates in ranking relative to the client's needs. In addition, the examiner relies on VP Forum for teaching that a lead manager determines the professionals the high net worth individual needs and makes assignments and referrals. The examiner concludes:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to automate the needs analysis and referral system to include ranking features based frequency of client need especially in customer relationship management systems, since it has

been held that broadly providing a mechanical or automatic means to replace manual activity that has accomplished that same result involves only routine skill in the art . . . Thus, it would have been within the level of ordinary skill in the art to modify the method of Moran by adopting the teachings of McGovern et al. and The VIP Forum to obtain a cost-efficient way of providing referrals to various professionals and specialists. [answer at page 5].

We will not sustain this rejection. We agree with the appellants that none of the references cited discloses the steps of determining the frequency of need of the services. In addition, we agree with the appellants that none of the references cited discloses assigning services to a core, affiliated and non-affiliated group based on the above determinations as required by claims 58 and 66 from which the remaining claims rejected by Moran, McGovern and VP Forum depend.

We will likewise not sustain the rejection of claims 65 and 73, which are dependent on claims 58 and 66 respectively, under 35 U.S.C. § 103 as being unpatentable over Moran, McGovern, VP Forum and further in view of Upbin as we have reviewed the disclosure of Upbin and determined that it does not cure the deficiencies noted above for Moran, McGovern and VP Forum.

In summary, we have not sustained the examiner's rejection of claims 58 to 75.

REVERSED

STUART S. LEVY
Administrative Patent Judge

ANTON W. FETTING
Administrative Patent Judge

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